



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,167	05/11/2001	Chen Sun		5913

7590 12/02/2004

WebAndNet Computing
c/o Chen Sun
5900 Ranchester Dr. #706
Houston, TX 77036

EXAMINER

THOMPSON, MARC D

ART UNIT	PAPER NUMBER
----------	--------------

2144

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,167

Applicant(s)

SUN ET AL.

Examiner

Marc D. Thompson

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

1. The response, received 7/21/2004, has been entered into record.
2. Claims 1-46 remain pending.

Priority

3. Receipt is acknowledged of intention to claim priority under 35 U.S.C. 119(e), to Choudhry et al. (US Patent Application Number 09/476,632, now Patent Number 6,442,602).

The incorporation by reference of the two prior filed documents, 09/476,632 and 09/642,127, is presumed valid, and acceptable. That is, the contents of these two documents, at the state of these documents at the time of filing of the present application, are fully incorporated by reference into the instant application.

4. The "microfiche" submission allegedly containing the programmatic code for the parent and instant applications, are presumed valid. See, Response filed 7/21/2004, Page 11, Section H. Direct first-person verification of this asserted fact is not readily ascertainable to the Examiner at this time. However, support for computer programmatic functionality commensurate with the disclosure, claimed invention, and discussion in the response, will be presumed to be present in this previously submitted documentation.

5. The new effective filing date for the subject matter defined in the pending claims in this application is 12/31/1999.

Drawings

6. The Examiner contends that the drawings submitted on 9/10/2001 are acceptable for examination proceedings.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of Choudhry (U.S. Patent No. 6,442,602), hereinafter referred to as Choudhry, in view of Celik (U.S. Patent Number 6,374,259), hereinafter referred to as Celik.

9. The present claims prescribe subject matter claimed in the patented document, minimally, with the further provision for online (electronic) business card information associated with computer users. Basic searching methodology, indexing, gateway interfacing, HTML delivery, and HTTP transports are further provided. While expressly providing the majority of the claimed invention limitations, the Choudhry patented document lends itself perfectly to the association of information with particular computer network user(s) (e.g., inter alia, Column 4, Lines 60-63, Column 7, Lines 14-46, Claim 9). Thus, the use of the virtual directory naming convention for organizing and accessing online information associated with a particular user would have been obvious to one of ordinary skill in the art at the time of invention armed with the teachings of the patented invention set forth in Choudhry, in combination with well known

Art Unit: 2144

online electronic digital business card storage and usage methodologies as provided by Celik, and additionally admitted as known prior art in the instant specification at Page 7-9 and Figure 4.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-46 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without resorting to undue experimentation.

12. Claims 1-46 are rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling. The details regarding generation and/or all potential functionality related to resolving of “virtual subdomains”, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

13. The claimed invention describes the “dynamic generation” of “virtual domains” for the purpose of business card organizing and accessing. It is unclear how this “dynamic generation” takes place, and how any results of this generation are used to organize or access online information. Further, the use of CGI scripts for potential resolving of HTML embedded addresses utilizing the virtual subdomain(s) is not set forth in the specification in sufficient detail to allow one skilled in the art to make and use the invention as claimed and disclosed. Examine, inter alia, Figures 4 and 5, and the associated descriptions within the specification. A skilled

Art Unit: 2144

artisan would be forced to resort to undue experimentation to make and use the invention given the level of disclosure set forth in the present specification.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

16. Claims 1-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chandra (U.S. Patent Number 6,085,242), hereinafter referred to as Chandra, in view of Celik (U.S. Patent Number 6,374,259), hereinafter referred to as Celik, or alternatively, over Celik in view of Chandra.

17. Chandra disclosed the use of personalized URL logical designators to specify specific personal associated information for a particular network user. See, inter alia, Abstract, Column 4, Lines 27-30, and Column 6, Lines 42-45. This information was envisioned to have been business card information. See, inter alia, Column 4, Lines 17-18, and Column 5, Lines 28-32. The database housing this information was optionally part of a web server, fully incorporating the transport protocols and hypertext formatting capabilities as known in the art. See, inter alia, Column 4, Lines 8-12. Specifically, the use of “virtual subdomains” was

Art Unit: 2144

expressly provided and utilized to reference database information. See, inter alia, Column 5, Lines 8-11, and Column 6, Lines 5-18. Lastly, the stored database information correlated directly to a dynamically generated logical designation, e.g., URL. See, Column 6, Lines 42-45. Also see Figures 5 and 6, which described the use of an arbitrary identifier for access to information associated with an individual (inherently present in any system accessing particular information for a particular entity), which redirected the browser to the actual information. This “dynamic” and open-ended functionality provided the simplistic ability to always (and dynamically) point to the current, most up-to-date information associated with the specified entity. See, inter alia, Column 6, Lines 54-56. Note “once updated, the new user information is immediately available...in this manner, the user information associated with a *user identifier* is always current and up to date. The “user identifier” (as opposed to a specific logical address) defined the subsequent access request using a “dynamically” defined mapping between user identifier and logical network address.

18. Since Chandra expressly disclosed the provision for electronic business card storage and access, one of ordinary skill in the art would have been motivated to search the related arts for electronic business card teachings compatible with the Chandra system.

19. In the same art of information organization, storage, access, and network retrieval, Celik disclosed various network database application programming interfaces (Column 5, Lines 45-50) serving to organize and update business card entries (inter alia, Column 1, Lines 46-49). The system was functional to search business card listings in order to query/filter the information within the database utilizing typical network mechanisms. See, inter alia, Column 6, Line 66 through Column 7, Line 20.

Art Unit: 2144

20. The system of Chandra suggestively using a database of business card information as disclosed would have been obviously modified with the business card information database system set forth by Celik in order to result in a system fully utilizing the business card database as directly suggested by Chandra as enabled by Celik. Conversely, the central storage, management, access, and retrieval of business card database information set forth by Celik, generating a unique user identifier (inter alia, Column 7, Lines 22-31) remained silent as to how this assignment was effected. An ordinary artisan working with the Celik system at the time of invention would have been motivated to explore the related arts for teachings resulting in a generation of unique user assignment(s), as disclosed by Chandra in, inter alia, Column 6, Lines 9-16, also dealing directly with business card network user data. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings set forth by Chandra and Celik to result in a business card database organization, access, and retrieval system using typical, known network software elements, database mechanisms, information transport, and display format processing.

Claims 1-46 are rejected.

Response to Arguments

21. The arguments presented by Applicant in the Response, received on 7/26/2004, are not considered persuasive.

22. Applicant argues “virtual subdomains” as known in the art at the time of filing were “not dynamically updatable”. See, Response, received 7/26/2004, Page 13, Section “e”. Further, the relied on portion of the specification which defines the virtual subdomain server referenced in this section states “The virtual subdomain server translates virtual subdomains to other types of

Art Unit: 2144

Internet addressing schemes such as subdirectory names or other domains and subdomains. As this is done in real time, the virtual subdomain may be repointed to any other destination address as desired dynamically.” This is equivalent to the association of a users personalized URL with a an actual routable address (path) to the user information as set forth in Chandra, Column 6, Lines 19-22. This association simply provided a mapping to between real network addresses used to retrieve information and other logical addresses, called by Applicant “virtual subdomains”. There is an inherent “dynamical” behavior of this address “resolving”, since a domain name server (DNS) or similar functional element was accessed to retrieve the actual network address of the desired resource. Thus, the bounds of what “dynamically updatable” is being used to describe, in combination with the currently understood definition of “virtual subdomain”, no distinction can be readily ascertained by the Examiner.

23. In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which applicant relies (i.e., “dynamically generated...”, unique subdomains, unregistered subdomains, unresolvable subdomains, etc.) are not specifically recited in the entirety of the rejected independent claim(s). Likewise, any presumed definitive meaning for “virtual subdomains” is not expressly provided in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

24. It is submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the

Art Unit: 2144

test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. Also, in response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the mapping between a user identifier and a logical network address, both of which *require* to have been resolved to effect information access and retrieval, broadly equate to the generalized characterization of "virtual subdomains", additionally in light of the lack of enablement and overly broad terminology. The use of term "virtual" is appropriate since the "subdomain" which is "virtual" are not real, physical addressing mechanisms. The resolution of logical names were notoriously well known and widely implemented in the art at the time of invention, and cannot be relied on to distinguish the claimed invention over the prior art of record. Also, any alleged differences between the Chandra and Celik individual teachings and the claimed invention as argued by Applicant in the Response, received 7/28/2004, Page 14, Section III, are not entirely understood, since the combination of Chandra and Celik provided unique identifiers which resolve into unique virtual subdomains, resolvable to unique address(es). See, Response, received 7/28/2004, Page 16, Section "d".

Applicant's arguments set forth in the Response, received 7/28/2004, Page 16, Sections "e" and "f", may fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references, or how the "less complex functionality" was achieved, and no convincing reasoning or explanation as to these

Art Unit: 2144

alleged differences are suitably described. Additionally, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

25. Applicant has had multiple opportunities to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP § 2111. Additionally, Applicant employs broad language which includes the use of words and phrases which have broad meanings in the art. Applicant has not amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly as reasonably possible, in determining patentability of the disclosed invention. The current claims infer coverage breadth which is inconsistent with breadth of the disclosure and are not found distinguishable above the prior art of record.

26. It is noted that the details of the prior Double Patenting rejection has been completely ignored in the response and is presumed to be misunderstood by Applicant. It is suggested that

Art Unit: 2144

this failure to address each and every section of the Office action not be repeated in order to advance prosecution of the application, and a terminal disclaimer be filed to obviate the repeating of this currently sustained rejection.

27. The discussion set forth by Applicant in regard to the “virtual subdomain” as claimed lacks generally clarity prohibiting a clear distinction of the claimed limitation(s) and the prior art of record. Applicant is advised to revise the definition of “virtual subdomain” in the claim(s), argue specifics as to what the “virtual subdomain” actually is with supporting portion(s) of the parent and current specification to allow proper claim construction and interpretation, and qualify each and every term used in the claims to unambiguously, particularly, and distinctly claim what it is the Applicant intends to cover with the presented claims. Clarification, clear definition, and unambiguous interpretation of the claimed subject matter is required to result in allowable claims. Examiner submits that the claims should be substantially revised in order to accurately reflect what the terms used in the claims actually describe.

Conclusion

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

29. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2144

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932.

The examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, Jr. can be reached at 571-272-3925. The fax phone number for the organization where this application or proceeding is assigned remains 703-872-9306.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER

Marc D. Thompson
Primary Examiner
Art Unit 2144